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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/866,546	05/25/2001	Jeyhan Karaoguz	41044/SDB/B600	4796

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EXAMINER

MARTINEZ, DAVID E

ART UNIT	PAPER NUMBER
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2182

DATE MAILED: 04/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/866,546

Applicant(s)

KARAOGUZ ET AL.

Examiner

David E Martinez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

Claims 14 and 20 objected to because of the following informalities: the word "a" before the word "performed" should be deleted on both claims. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-8, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claims 3-8 contain the trademarks/trade names "Bluetooth" and "HomeRF". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade

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name. In the present case, the trademark/trade name is used to identify/describe different types of wireless communication standards, accordingly, the identification/description is indefinite.

Furthermore, Claims 6-8 contain the 802.11b standard also creates an indefinite situation since standards are always subject to interpretation and are constantly being updated to different specification versions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-2, 9-11, 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,546,211 to Devon.

1. With regards to claims 1 and 2, Devon teaches a method for controlling and managing wireless RF network access for a wireless communication device [abstract], comprising the steps of:

sequentially attempting to determine whether communications may be established with least one a plurality wireless RF networks [column 5 line 64 to column 6 lines 4, and 27-35];

selecting least one of the wireless networks [column 5 line 64 to column 6 lines 4, and 27-44]; and

establishing communications between the wireless communication device and least one selected wireless network [column 5 line 64 to column 6 lines 4, and 27-44].

Devon teaches all of the above limitations but is silent as to using the above method with wireless RF networks. However, Devon teaches RF networks provide relatively high data rates over relatively long distances [column 1 lines 24-26].

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine all of the teachings of Devon to perform the above method with wireless RF networks for the benefit of providing relatively high data rates over relatively long distances.

2. With regards to claims 9 and 15, Devon teaches the method of claim 1 comprising sequentially scanning a first network and a second network [Nevo abstract, column 3 lines 28-45, column 4 lines 13-15, 46-55, and Devon, abstract, column 2 lines 30-36, column 5 line 64 to column 6 lines 4, and 27-35] for the same reasons as those set forth in claim 1 above.

With regards to claims 10 and 16, Devon teaches the method of claim 1 comprising scanning a during a first scanning window and scanning a second network during a second scanning window [abstract, column 2 lines 30-36, column 5 line 64 to column 6 lines 4, and 27-35] for the same reasons as those set forth in claim 1 above.

3. With regards to claims 11 and 17, Devon teaches the method claim 10 wherein the first scanning window comprises a first predefined time period and the second scanning window comprises second predefined time period [abstract, column 2 lines 30-36, column 5 line 64 to column 6 lines 4, and 27-35] for the same reasons as those set forth in claim 1 above].

Claim 3-8, 12-14, 18-20, are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,546,211 to Devon in view of US Patent No. 6,600,726 to Nevo et al.

4. With regards to claims 3, 4, 6, 7, Devon teaches all of the limitations as disclosed to the steps and functions for claims 1 and 2 above except for the use of any two of the Bluetooth, HomeRF, and 802.11b network protocols.

However, Devon does teach RF networks provide relatively high data rates over relatively long distances [column 1 lines 24-26]. Nevo teaches the use of any two of the Bluetooth, HomeRF, and 802.11b networks protocols (Bluetooth, HomeRF, and 802.11b all being different RF protocol standards) in a dual-mode controller for a wireless device for the benefit of being able to communicate with a broad range of devices that use different protocols [column 3 lines 28-45, column 4 lines 13-15, 46-55]. In addition, Bluetooth, HomeRF and 802.11b network protocols are well known in the art as admitted by the Applicant Remarks.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Devon, Nevo and those that are well known, to include any two of Bluetooth, HomeRF, or 802.11b network protocols to perform the above steps/functions for the benefit of being able to communicate with a broad range of devices that use different protocols and for the benefit of providing relatively high data rates over relatively long distances.

5. With further regards to claims 4 and 7, they are rejected under the same rationale as claim 3 above except for notifying the user of availability of types of networks and selecting a Bluetooth or a HomeRF network or an 802.11b network according user input. However, Hollstrom teaches a wireless device that displays to a user, modules available to communicate with, wherein the modules use different protocols for communication (bluetooth, cable, rs232). Hollstrom also discloses selection of a module as per user input [paragraphs 25 and 28, see figures 1 and 2]. Hollstrom does this to provide an easier way of accessing, controlling and operating electronic utility devices in a standardized and user-friendly fashion, and to drastically reduce the number of required control units so that one control apparatus is requires to control a large number of electronic devices.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Devon, Nevo, and Hollstrom to notify the user of availability of types

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of networks and selecting from a Bluetooth, a HomeRF or an 802.11b network according to user input for the benefit providing an easier way of accessing, devices in a standardized and user-friendly fashion, and to drastically reduce the number of required control units so that one control apparatus can access a large number of electronic devices.

6. With regards to claims 5 and 8, the combination of Devon and Nevo teach using common radio circuitry for communications with any networks that operate in accordance with the Bluetooth, HomeRF, or 802.11b standards [Nevo column 3 lines 28-45, column 4 lines 13-15, 46-55] for the same reasons as claims 3-7 above.

With regards to claims 12 and 18, it is well known in the art for scanning windows to be of equal predetermined time in order to be fair, and to prevent starvation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have the first predefined time period equal the second predefined time period in order to be fair, and to prevent starvation.

7. With regards to claims 13 and 19, it is well known in the art for a wireless device to perform multiple scans when searching for a network. A conventional cellular phone is an example of a wireless device that performs multiple scans for a network signal that uses different protocols to communicate at different frequencies for the benefit of establishing a connection for communication to take place. It would have been obvious to one of ordinary skill in the art to perform multiple scans during the first scanning window and performing multiple scans during the second scanning window such as what a conventional cellular phone does for the benefit of establishing a connection for communication to take place.

8. With regards to claim 14 and 20, Devon is silent as to wherein each of the multiple scans during each scanning window is performed for a predefined time period. However, Devon teaches a scanning window is performed for a period of predetermined length and then

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switching to a different protocol to be able to try to detect all supported protocols [column 5 line 64 to column 6 lines 4, and 27-44]. It would have been obvious to one of ordinary skill in the art at the time of the invention to have each of the multiple scans during each scanning window perform for a predefined time period to be able to try to detect all supported protocols.

Response to Arguments

Applicant's arguments with respect to the 112 2nd paragraph rejection to claims 3-8 have been fully considered but they are not persuasive.

With respect to claims 3-8 Bluetooth, and HomeRF, as disclosed above, the claims are not sufficiently definite. Although they are well known standards as asserted by the applicant, they are standards that are always subject to interpretation and are constantly being updated to different specification versions. Furthermore, where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). Furthermore, the claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. In fact, the value of a trademark would be lost to the extent that it became descriptive of a product, rather than used as an identification of a source or origin of a product. Thus, the use of a trademark or trade name in a claim to identify or describe a material or product would not only render a claim indefinite, but would also constitute an improper use of the trademark or trade name. See MPEP 2173.05(u)

In addition, regarding the other patents the applicant cites to have the Bluetooth and HomeRF trademarks in the claims, every patent is presumed to be valid. Public policy demands that every employee of the USPTO refuse to express to any person any opinion as to the

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validity or invalidity of, or the patentability or unpatentability of any claim in any U.S patent, except to the extent necessary to carry out a reissue, a reexamination or an interference. The question of validity or invalidity is otherwise exclusively a matter to be determined by a court. See MPEP 1701.

Applicant's arguments with respect to the 102 rejection of claims 1,2, 9-11 and 15-17, have been fully considered but they are not persuasive.

With regards to claims 1 and 2, Devon teaches the use of RF networks as disclosed above under the claim rejection of such claims. Claims 9-11 and 15-17 depend from claims 1 and 2 respectively and their rejections are maintained.

Applicant's arguments with respect to the 103 rejection of claims 3-8, 12-14 and 18-20, on page 12 of the remarks, lines 10-26 have been fully considered but they are not persuasive.

With regards to claims 3, 4, 5, 6, 7 and 8, Devon clearly teaches the use of RF networks to provide relatively high data rates over relatively long distances [column 1 lines 24-26]. There is no implicit assumption being relied upon by the examiner since the benefit can be found right on the Devon reference. Bluetooth, HomeRF and IEEE 802.11b (taught by Nevo, and also are all network standards which are well known in the art as admitted by the applicant) all fall within the scope of RF communication protocols. Furthermore, Devon discloses the sequential techniques being claimed by the applicant on column 5 line 64 to column 6 lines 4, and 27-35. As shown above, Devon also discloses that RF networks provide the benefit of having relatively high data rates over relatively long distances [column 1 lines 24-26] and thus it would have been obvious for Devon to use his sequential techniques with RF networks for those benefits mentions above.

With regards to claims 5 and 8, Devon discloses the use of his sequential techniques with RF networks for those benefits mentions above, and Nevo discloses a common radio

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circuitry for communications with any networks that operate in accordance with the Bluetooth, HomeRF, or 802.11b standards [Nevo column 3 lines 28-45, column 4 lines 13-15, 46-55]. The combinations of Devon and Nevo is obvious for the same reasons set forth above.

With regards to claims 12-14 and 18-20, "performing multiple scans" would have been obvious for the reasons set forth above under the claim rejections.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E Martinez whose telephone number is (571) 273-4152. The examiner can normally be reached on 8:30-5:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A Gaffin can be reached on (571) 272-4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEM



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